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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,985	08/18/2006	Moritz Bunemann	VOSS:008US/10506359	2063
33425 7590 12/28/2010 FULBRIGHT & JAWORSKI L.L.P. 600 CONGRESS AVE. SUITE 2400 AUSTIN, TX 78701				
EXAMINER				
PAK, MICHAEL D				
ART UNIT		PAPER NUMBER		
1646				
NOTIFICATION DATE		DELIVERY MODE		
12/28/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

aopatent@fulbright.com

Office Action Summary

Application No.

10/538,985

Applicant(s)

BUNEMANN ET AL.

Examiner

Michael Pak

Art Unit

1646

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 4-31 is/are pending in the application.
- 4a) Of the above claim(s) 11-23 and 26-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-10, 24, 25 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on July 20, 2010 has been entered.

Response to Amendment

2. Amendment filed January 22, 2010 has been entered.
3. Applicant's arguments filed January 22, 2010, have been fully considered but they are not found persuasive.
4. Claims 1-2, 4-10, 24-25 and 31 are being examined. Claims 11-23 and 26-30 have been withdrawn. Claim 3 has been cancelled.
5. The Declaration of Carsten Hoffmann under 37 CFR 1.132 filed January 25, 2010 is sufficient to overcome the enablement rejection of claims based upon 35 USC 112 paragraph one.

Claim Objections

6. Claims 6, 24 and 25 is objected to because of the following informalities.

Appropriate correction is required.

Claim 6 recite the term "origen" which appears to be a misspelling of origin.

Claims 24 and 25 are dependent on non-elected claims which is confusing and can only be examined in part.

Applicants traverse the rejection indicating that the non-elected claims are still pending. However, the objection is maintained for the reason stated above.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-2, 4-10, 24-25 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recite claim 3 which is cancelled which is confusing and ambiguous.

Claims recite or encompass the amended claim terms "G-protein coupled receptor of human or mouse origin" which is ambiguous and the metes and bounds of the terms are not clear. The claims are not limited by structural limitations and it is not clear when a receptor is of human or mouse origin because the receptor have mutations which changes the structure of the receptor from the originally isolated receptor. Once the structure is changed then it is not clear when the receptor belongs either mouse or human origin since it is not in the original structure anymore. The structural limitations which makes a receptor a mouse or a human origin is not known and the metes and bounds is not clear when a receptor meets these structural limitations.

Claims recite or encompass the term "stringent hybridization conditions" or "stringent conditions" in claims 9 and 10 which is a relative term whose metes and bounds are not clear. Applicants argue that specification on page 23 provide support for the claim amendments. However, the term is not defined in the specification on page 23. Furthermore, stringent hybridization conditions have specific temperature and salt conditions as well as washing conditions. The metes and bounds are not clear because it is not clear when a condition is stringent or any other term which describes a hybridization condition. The nucleic acid hybridization conditions are based on Cot1/2 determination of reassociation and there is not an absolute correlation between the hybridization conditions and Cot1/2. The reassociation kinetic is a statistical average and there are structurally unrelated nucleic acids which bind including nonspecific binding molecules. Thus, the nucleic acid which would encode a protein after stringent hybridization condition is unclear. Claims 1-2, 4-8, 24-25 and 31 encompass the term.

Applicants argue that the term is well known in the art as evidenced by the enclosed excerpt from the Sambrook laboratory manual. However, there is no discussion of the term "stringent hybridization conditions" in the excerpt.

8. No claim is allowed.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pak whose telephone number is 571-272-0879. The examiner can normally be reached on 8:00 - 2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Nickol can be reached on 571-272-0835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Michael Pak/
Primary Examiner, Art Unit 1646